

REMARKS

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

Status of the Claims

Claims 1-16 are pending. Claims 1 and 11 have been amended. Claims 12-16 have been added. No new matter has been added.

Applicants appreciatively acknowledge the Examiner's indication of allowable subject matter in claims 4-7, 9 and 11. Added claim 12 corresponds to claim 4 written in independent form. Added claims 13-16 respectively correspond to claims 5-7 and 9, but depend from claim 12. Applicants submit that claims 12-16 are patentable and request that the Examiner pass these claims to allowance.

Rejection under 35 U.S.C. § 103

Claims 1-3, 8 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,657,593 to Nagumo et al. ("Nagumo") in view of U.S. Patent No. 6,535,170 to Sawamura et al. ("Sawamura").

The Examiner contends that Nagumo discloses most of the features of claims 1-3, 8 and 10 including a monopole element with a parasitic element coupled to the signal ground. The Examiner acknowledges that Nagumo does not disclose a single matching element connected between the parasitic element and the signal ground. However, the Examiner cites Sawamura as disclosing a matching coil element 231 connected between the antenna element and the signal ground. The Examiner states it would have been obvious for a person of ordinary skill in the art at the time of the invention to combine Nagumo and Sawamura to achieve the invention of claims 1-3, 8 and 10.

Applicant submits that Nagumo discloses two radiating elements 3, 4. The first radiating element 3 is connected to the a transmitting source 10 through a feed conductor 5 and a matching circuit 8. The second radiating element 4 is parasitic and connected to the ground through ground conductor 6. The Examiner refers to Nagumo, Fig. 7 as disclosing radiating element 3 as having two branches for implementing an additional operating band. The Examiner states that the parasitic element disclosed in Nagumo does not have a matching element. Sawamura discloses two radiating elements both fed from a source 14 through feed pin 13, or alternatively through separate feed pins 13H, 13L. Sawamura discloses that antenna matching is implemented in matching circuit 23 located at the shared feed conductor. Sawamura discloses a sheer coil 231 connected from the feed conductor to ground.

Applicants submit that the Examiner's combination of Nagumo and Sawamura results in device different from the claimed invention. Specifically, Applicants submit that Nagumo discloses a matching circuit 8 similar to Sawamura's matching circuit 23. The combination of Nagumo and Sawamura results in connecting the sheer coil 231 disclosed in Sawamura to Nagumo's feed conductor.

Independent claims 1 and 10 recite "a single matching element connected between the parasitic element and the signal ground." In contrast, Nagumo and Sawamura result in the sheer coil being connected between the feed conductor and ground. Applicants submit that there is no motivation in Nagumo or Sawamura to connect the matching circuit between the parasitic element and the signal ground.

In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, "[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.

2d 1780, 1783 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated: “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Applicant’s disclosure.” *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

As is demonstrated above, there is no suggestion in Nagumo or Sawamura to combine these references, and the combination results in a device different from the claimed invention. Instead, the Examiner has impermissibly relied on the disclosure of the present application “to reconstruct the patentee’s claimed invention from prior art by using the patentee’s claim as a ‘blueprint’ when prior art references require selective combination to render obvious a subsequent invention.” (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, citing *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

Claims 2-3 and 8 depend from claim 1, and each recites the features of claim 1 as if set forth therein in their entirety. Applicants submit that neither Nagumo nor Sawamura disclose, or suggest, singly or in combination the features of claims 2-3 and 8 for at least the same reasons as demonstrated above for claim 1. Therefore, Applicants submit that claims 2-3 and 8 are patentable over Nagumo and Sawamura. Thus, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness over claims 2-3 and 8. Reconsideration and withdrawal of the rejection is requested.

CONCLUSION

Each and every point raised in the Office Action dated February 9, 2005 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-16 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: May 9, 2005

Respectfully submitted,

By 

Richard J. Katz

Registration No.: 47,698

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant